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Andrew D. Dingsor

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EXAMINER

SWEARINGEN, JEFFREY R

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW D. DINGSOR and CRAIG A. LANZEN

Appeal 2008-0806
Application 09/803,825
Technology Center 2100

Decided: July 31, 2008

Before JAMES D. THOMAS, JOSEPH L. DIXON, and STEPHEN C. SIU,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-21. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

BACKGROUND

Appellants' invention relates to network address translation (NAT) and port mapping. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of processing a client packet sent from a client to a NAT system including a NAT machine and a plurality of servers, said NAT machine performing an inbound translation on said client packet and forwarding said translated client packet to one of the plurality of servers, the method comprising the steps of:

preparing, by said one of the plurality of servers, a response packet responsive to the client packet;

performing, by said one of the plurality of servers, a translation operation on the response packet to produce a translated response packet; and

transmitting the translated response packet directly to the client from said one of the plurality of servers, thereby bypassing the NAT machine.

PRIOR ART

The prior art reference of record relied upon by the Examiner in rejecting the appealed claims is:

Borella

US 6,353,614 B1

Mar. 5, 2002
(filed Mar 5, 1998)

REJECTIONS

Claims 1-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Borella.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Apr. 16, 2007) for the reasoning in support of the rejections, and to Appellants' Brief (filed Mar. 30, 2007) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have carefully considered Appellants' Specification and claims, the applied prior art reference, and the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we determine the following.

35 U.S.C. § 102

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim" *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the

scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

With respect to independent claim 1, Appellants argue that:

The present invention addresses the standard problem of "bottlenecking" in a Network Address Translation (NAT) system. Typically, traffic slows at a NAT machine due to the large volume of traffic being process [sic processed] by the NAT machine. The present claimed invention first performs an initial packet address translation at the NAT machine, and then performs additional packet address translation at any individual servers relaying information to a client machine, thereby allowing a direct connection between the clients and servers after the initial NAT translation. By utilizing this configuration, a large volume of traffic at the NAT machine is offloaded to individual servers after the initial address translation....

In these steps, the forwarded packet is processed at the receiving server. The receiving server creates a response packet and translates this packet. This translation step includes including a unique address for the receiving server as opposed to the genetic system address. By

performing this further translation step, the receiving server and client can now communicate directly without requiring further communication with the NAT machine, effectively bypassing the NAT machine. Each additional independent claim (Claims 9 and 15) recites a form of these limitations. This configuration is neither taught nor suggested by the prior art of record.

(Br. 6-7).

From our review of the teachings of Borella, we agree with Appellants that the router 26 functions as the NAT machine in Borella. From our review of the teachings of Borella and the Examiner's cursory statement of rejection in the Answer at pages 3-5, we do find that the Examiner has not addressed the merits of the claimed invention with respect to the server rather than a router performing the translation operation. The Examiner states at page 5 of the Answer that "[i]t is well known in computing that separate modules or processing cards are present in an individual computer, server, or router, to handle separate tasks. In this case, Borella used a NAT function on the outbound side, but not on the inbound side. Borella *ide. [sic]* Borella bypassed the NAT machine." We do not readily find that the Examiner's stated rejection and the Examiner's responsive arguments squarely address the argued difference between the teachings of Borella and the claimed invention which clearly recites the functions being performed by one of the servers and that this process thereby bypasses the NAT function.

Since we do not readily find the recited claim limitations in the teachings of Borella, we cannot find that the Examiner has set forth a prima facie case of anticipation of independent claim 1 and its respective dependent claims 2 -8. We find similar limitations in independent claims 9

and 15, and similarly, we do find that the Examiner has clearly not set forth a sufficient initial showing of anticipation for these claims. Therefore, we cannot sustain the rejection of independent claims 9 and 15 and their respective dependent claims 10-14 and 16-21.

CONCLUSION

To summarize, we have reversed the rejection of claims 1-21 under 35 U.S.C. § 102.

REVERSED

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